

number of operational parameters in the process and uncertainty as to the mechanism of the winning process.

On page 12, lines 14-19, and in Fig. 3, it is described that, in one embodiment of the invention, the bonus hit value by the individual machine plus the previous common bonus count need to be equal to or greater than 30 for the player to win a bonus award. Accordingly, the specification specifically teaches one of ordinary skill in the art the amount of hit counts to win a bonus award.

Additionally, the pending Claims 1-16 are not limited to a device requiring hit counts.

#### Double Patenting

The Examiner indicated that the present claims are obvious over the claims in the U.S. Patent No. 6,012,982 and stated that the present application and the '982 Patent had the identical specification. The present application, however, is a CIP of the application which resulted in the '982 Patent. It is Applicants' belief that the pending claims are not obvious in view of the claims in the '982 Patent since the patented claims do not suggest the limitations in the presently pending claims, and the pending claims are partly supported by the added matter in the present CIP.

In any event, to expedite the granting of a patent, Applicants submit a Terminal Disclaimer without any admission that the present claims are obvious over the patented claims.

#### Claim Rejections-35 U.S.C. § 102

The Examiner rejected Claims 1-16 as being anticipated by Marnell II (U.S. Patent No. 5,393,057).

LAW OFFICES OF  
SKJERVEN MORRILL  
MACPHERSON LLP  
25 METRO DRIVE  
SUITE 700  
SAN JOSE, CA 95110  
(408) 453-9200  
FAX (408) 453-7979

The Marnell patent was cited by the Applicants along with the present application, and the claims were drafted to be patentable over the Marnell disclosure. All embodiments described by Marnell use a display for the bonus game (the secondary game) that is separate from the display for the primary game. This adds considerable cost to the system as well as increases the size of the gaming apparatus. There is no suggestion whatsoever for at least the element in Claim 1 of: "generating and displaying said first game result and said bonus game result being performed by the same hardware in said slot machine so as to require no additional hardware to generate and display said bonus game result." Marnell clearly discloses a separate display (additional hardware) for the bonus game result. Additionally, Marnell's bonus game requires additional wiring and other circuitry hardware in addition to a separate display.

Where the Examiner indicates on page 3 of the Office Action that Marnell's system displays two games in one machine "using the same circuitry," the Examiner is ignoring at least the display and wiring for the display and other controlling electronics for the bonus display.

If the Examiner persists in the Examiner's rejection, the Examiner is respectfully requested to point out in Marnell where there is a suggestion for displaying the bonus game and the primary game on the same display.

LAW OFFICES OF  
SKJERVEN MORRILL  
MACPHERSON LLP  
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SUITE 700  
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FAX (408) 453-7979

Applicants' claims are neither anticipated nor suggested by Marnell and a Notice of Allowance is respectfully requested.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231, on April 3, 2001.

  
R. S. [Redacted]  
Attorney for Applicant(s)

4/3/01  
Date of Signature

Respectfully submitted,

  
Brian D. Ogonowsky

Brian D. Ogonowsky  
Attorney for Applicant(s)  
Reg. No. 31,988

LAW OFFICES OF  
SKJERVEN MORRILL  
MACPHERSON LLP  
  
25 METRO DRIVE  
SUITE 700  
SAN JOSE, CA 95110  
(408) 453-9200  
FAX (408) 453-7979

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